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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,510	12/14/2001	Syunji Sugaya	P/2850-53	4552
2352 7590 05/26/2009 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER BOVEJA, NAMRATA	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 05/26/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/018,510	<b>Applicant(s)</b> SUGAYA, SYUNJI	
	<b>Examiner</b> NAMRATA BOVEJA	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 1-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 55-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This office action is in response to the RCE communication filed on 02/23/2009.
2. Claims 1-54 have been cancelled. Claims 55-68 are presented for examination.
3. Amendments to claims 55-68 have been entered and considered.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. *Claims 55-63 and 65-68 are rejected under U.S.C. 103(a) as being unpatentable over Servan-Schreiber (Patent Number 6,892,354 hereinafter Servan-Schreiber) in view of Official Notice.*

*In reference to claim 55, Servan-Schreiber teaches an advertisement presentation system according to comprising: a server connected to a network (abstract, col. 1 lines 58-63, col. 2 lines 1-10, col. 3 lines 6-21, and col. 5 lines 21-31); an advertisement server configured to distribute an advertisement (abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21); and a user side equipment configured to present the advertisement received from the advertisement received from the advertisement server, while conducting an*

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*operation of transmitting/receiving data to/from the server via the network*

*(abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21).*

*Servan-Schreiber is silent about the user side equipment, when detecting a purchase request being effective to transmit the purchase request to the advertisement server. Official Notice is taken that it is old and well known for the user side equipment, when detecting a purchase request being effective to transmit the purchase request to the advertisement server. For example, if a user clicks on an advertisement by a company to purchase the advertised product, this information is communicated to the advertisement server so that the user can complete the order process by entering his identification and shipping information for example. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention for the user side equipment, when detecting a purchase request being effective to transmit the purchase request to the advertisement server to enable the user to carry out the purchase by supplying identification and shipping information.*

5. *In reference to claim 56, Servan-Schreiber teaches an advertisement presentation system wherein, when the user side equipment detects an operation of interrupting the advertisement while presenting the advertisement, the user side equipment is effective to conduct a predetermined operation on target data which is downloaded or is being downloaded from the server (col. 3 lines 44-67).*

6. *In reference to claim 57, Servan-Schreiber teaches an advertisement presentation system, wherein the predetermined operation is a removing operation (col. 3 lines 44-67).*

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7. In reference to claim 58, Servan-Schreiber teaches an advertisement presentment system that downloads target data from a server (col. 3 lines 10-43). Servan-Schreiber is silent about after downloading of the target data, if the user side equipment is effective to detect an error while transmitting upload data to the advertisement server, the user side equipment transmits the upload data when the user side equipment detects an establishment of connection to the network. Official Notice is taken that it is old and well known after downloading of the target data, if the user side equipment is effective to detect an error while transmitting upload data to the advertisement server, for the user side equipment to transmit the upload data when the user side equipment detects an establishment of connection to the network. For example, if a user clicks on a webpage URL and completes a form, the server can save a draft copy of the work in progress such that when the user transmits the form and it does not transmit for some reason, the can re-transmit the form without having to fill in the information again. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention after downloading of the target data, if the user side equipment is effective to detect an error while transmitting upload data to the advertisement server, for the user side equipment to transmit the upload data when the user side equipment detects an establishment of connection to the network to save the user time in having to complete the information again.

8. In reference to claim 59, Servan-Schreiber teaches a system for requesting said user to input information interactively (i.e. user clicks on or

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*manually enters a hyperlink request) when data is uploaded and transferred between said server and said user side equipment via said network (abstract, col. 2 lines 49-65, and Figure 2). Servan-Schreiber is silent about the upload data including a reply to a questionnaire and personal characteristic information.*

*Official Notice is taken that it is old and well known to request users to input responses to questions and provide their characteristic information and then to upload this information. For example, online retailers and brick and mortar stores frequently administer surveys online to better understand their customers. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include requesting users to input responses to questions and provide their characteristic information and then to upload this information to enable the advertiser to learn about the customers and to target advertisements more effectively for the customers.*

9. *In reference to claim 60, Servan-Schreiber teaches an advertisement presentation system wherein, the advertisement transmitted from the advertisement server comprises plural and various advertisements, and after downloading target data from the server, each time when the target data is used, the user side equipment selects and presents one of the advertisements which is different from previously presented advertisement (col. 3 lines 54-67, col. 4 lines 31-60, and col. 5 lines 8-19).*

10. *In reference to claim 61, Servan-Schreiber teaches an advertisement presentation system wherein, after presenting all of the advertisements, the user side equipment conducts an operation on the target data to be made impossible*

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(col. 3 lines 44-67).

11. In reference to claim 62, Servan-Schreiber teaches an advertising system wherein the advertisement comprises plural and various advertisements (col. 5 lines 8-20). Servan-Schreiber is silent about teaching that after downloading the target data from the server, each time the target data is used, the user side equipment cyclically or randomly presents the advertisements. Official Notice is taken that it is old and well known after downloading the target data from the server, each time the target data is used, for the user side equipment to cyclically or randomly present the advertisements. For example, online newspaper websites rotate advertisements with an advertising rotator to prevent the user from seeing stale advertisements each time the user accesses a page on the website. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include after downloading the target data from the server, each time the target data is used, for the user side equipment to cyclically or randomly present the advertisements to enable the users to view fresh advertisements that are meaningful.

12. In reference to claim 63, Servan-Schreiber teaches user side equipment for presenting advertisements to a user while transferring/transmitting data with said server via said network (abstract, col. 2 lines 1-10 and 39-48, and col. 2 lines 66 to col. 3 lines 21). Servan-Schreiber does not teach that in parallel to transmitting data to or from a server via a network, the user side equipment conducts defragmenting or deletes unnecessary files from said user side equipment.

*Official Notice is taken that it is old and well known to defragment and delete unnecessary files on the user side equipment while data is transferred to or from a server via a network. For example, many companies use programs such as Adaware etc to delete unnecessary spyware files and to optimize space on the hard drive. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to defragment and delete unnecessary files on the user side equipment while data is transferred to or from a server via a network to prevent spyware from being installed on the user side equipment.*

13. *In reference to claim 65, Servan-Schreiber teaches an advertisement presentation system wherein, until the end of presenting the advertisement, the user side equipment suspends a downloading operation of a portion of the target data (col. 3 lines 22-43 and col. 4 lines 24-41).*

14. *In reference to claim 66, Servan-Schreiber teaches an advertisement presentation system wherein, at the end of presenting the advertisement, the user side equipment conducts a downloading operation of the portion of the target data (col. 3 lines 22-43 and col. 4 lines 24-41).*

15. *In reference to claim 67, Servan-Schreiber teaches an advertisement presentation system wherein, the user side equipment is effective to receive a URL showing a location of the portion of the target data from the advertisement server and to conduct a downloading operation of the portion of the target data in reference to the URL (col. 3 lines 22-43 and col. 4 lines 24-41).*

16. *In reference to claim 68, Servan-Schreiber teaches an advertisement*



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*presentation system wherein said user side equipment presents the advertisements to the user while downloading data to said server via said network and during idle and wait time (col. 1 lines 47-63, col. 2 lines 1-10 and 49-65, col. 3 lines 22-43, and Figure 5A). Servan-Schreiber does not specifically recite presenting advertisements while uploading data to said server via said network, even though uploading also leads to an idle and wait time.*

*Official Notice is taken that is old and well known to present advertising content while uploading data to a server via a network to make an effective use of wait time as done by e-mail providers such as Juno when users are waiting to upload file attachments to their e-mail messages to help keep the e-mail service free of charge to the users and to give users something to look at while waiting on their computers for the upload to be completed. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include presenting advertisements during uploading of data to provide the users with targeted advertising for viewing while waiting for the upload to be completed.*

17. *Claim 64 is rejected under U.S.C. 103(a) as being unpatentable over Servan-Schreiber in view of Official Notice and further in view of Gephardt et al. (Patent Number 5,734,843 hereinafter Gephardt).*

*In reference to claim 64, Servan-Schreiber does not teach an advertisement presentation system wherein, the user side equipment is effective to calculate a time necessary for presenting the advertisement up to the end and, based on a transmission speed of a communication line and a size of the target*

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*data, adjusts a data transfer speed applied to download the target data in order to finish the downloading operation in the calculated time.*

*Gephardt teaches an advertisement presentation system wherein, the user side equipment is effective to calculate a time necessary (i.e. it is inherent that time is being calculated in Gephardt) for presenting the advertisement up to the end and, based on a transmission speed of a communication line and a size of the target data, adjusts a data transfer speed applied to download the target data in order to finish the downloading operation in the calculated time (col. 5 lines 10-39). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Servan-Schreiber to include user side equipment that is effective to calculate a time necessary for presenting the advertisement up to the end and, based on a transmission speed of a communication line and a size of the target data, adjusts a data transfer speed applied to download the target data in order to finish the downloading operation in the calculated time to ensure that the bandwidth can be optimized while minimizing the likelihood of dropped frames.*

### **Response to Arguments**

18. After careful review of Applicant's remarks/arguments filed on 02/23/2009, the Examiner fully considered the arguments, but they are moot in view of the new ground(s) of rejection. Amendments to claims 55-68 have been entered and considered.

19. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the

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amendments.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The Examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The Central FAX Number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

/NAMRATA BOVEJA/

Examiner, Art Unit 3622